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### **REMARKS**

Claims 9-13 are added. The new claims are supported by the specification, for example, in the claims as originally filed, and at page 11, first full paragraph, page 12, second full paragraph. No new matter is added by the new claims.

Claims 8-13 are pending. Applicant respectfully requests reconsideration of the application in view of the following remarks.

### **Rejections Under 35 U.S.C. §102(b)**

Claim 8 is rejected under 35 U.S.C. §102(b) as being anticipated by the English Abstract of Australian publication AU 9640808A.

The Office Action states that AU 9640808A discloses a polyester film that can be coated on both sides with an adhesive that contains pyrrolidinium rings. The Examiner states that the polyester film is transparent, and that Applicants admit that the acrylic-based adhesive and antistatic layer of AU 9640808A are transparent, and inherently maintain this transparency after one hour at 150°C.

Applicants respectfully traverse.

Claim 8 recites, *inter alia*, a transparent base material film, a transparent adhesive layer formed on one side of the base material film, and a transparent antistatic layer formed on the other side of the base material film.

AU 9640808A does not disclose that any component of the disclosed adhesive polymer film is transparent. Regarding the base material film, AU 9640808A discloses, "Partic. white polyester film is used in magnetic cards, e.g. telephone cards and prepaid cards. The film may also be used for magnetic disks." Thus, AU 9640808A discloses that the polyester film is white, not transparent. As such AU 9640808A does not disclose all elements of Claim 8 and, therefore, does not anticipate Claim 8.

Furthermore, Applicants make no admission regarding the transparency of the acrylic-based adhesive and antistatic layer of AU 9640808A. Applicants' specification does not refer to AU 9640808A, and makes no comment about layers that are necessarily identical to those used in AU 9640808A. AU 9640808A discloses that "a printing ink layer is mainly present on the surface of the other adhesive coating films." Thus, if anything, AU 9640808A discloses that printing ink,

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which is not transparent, is a component of the disclosed adhesive polymer film. Thus, there is no basis in Applicants' specification or AU 9640808A that the acrylic-based adhesive and antistatic layer of AU 9640808A are transparent, and, if anything, there is indication that the film of AU 9640808A is not transparent.

Applicants also submit that the film of AU 9640808A would not necessarily maintain transparency even after one-hour heat treatment at 150°C. In view of the comments above, there is no reason to believe that the film of AU 9640808A is ever transparent. Thus, there is no basis for concluding necessarily must maintain transparency even after one-hour heat treatment at 150°C. Accordingly, this property is not inherent in the film of AU 9640808A.

In view of the above, Applicants submit that Claim 8 is novel over the film of AU 9640808A, and respectfully request removal of this ground for rejecting Claim 8.

Claim 8 is rejected under 35 U.S.C. §102(b) as being anticipated by the Malhotra (U.S. Pat. No. 5,534,374).

The Office Action states that Malhotra discloses a transparent polyester substrate. The Office action also states that the adhesive of Malhotra can be acrylic-based, which is known to be transparent as admitted at page 8 Applicants' specification, the antistatic layer of Malhotra comprises an antistatic agent, such as pyrrolidine acid salt compounds and would be inherently transparent as admitted at page 12 in Applicants' specification. The Office Action further states that the laminate will inherently exhibit the maintaining of the transparency under the conditions recited in Claim 8.

Applicants respectfully traverse.

Malhotra does not disclose an antistatic layer comprising polymers having pyrrolidinium rings in their main chains. Accordingly, Malhotra does not teach all elements of Claim 8 and, therefore, does not anticipate Claim 8.

Regarding the adhesive layer and antistatic layers of Malhotra, Applicants' specification does not refer to Malhotra, and makes no comment about layers that are necessarily identical to those used in Malhotra. Accordingly, there is no basis for concluding that Applicants admit that the adhesive and antistatic layers of Malhotra are transparent. Nor does Malhotra disclose any instance in which all three of a base material film, adhesive layer, and an antistatic layer are

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transparent. Accordingly, Malhotra does not necessarily disclose a transparent surface protective film that contains a transparent base material film, a transparent adhesive layer formed on one side of the base material film, and a transparent antistatic layer formed on the other side of the base material film. Thus, Malhotra further does not anticipate Claim 8.

Applicants also submit that the film of Malhotra would not necessarily maintain transparency even after one-hour heat treatment at 150°C. In view of the comments above, there is no reason to believe that the film of Malhotra is necessarily transparent. Thus, there is no basis for concluding that the film of Malhotra necessarily must maintain transparency even after one-hour heat treatment at 150°C. Accordingly, this property is not inherent in the film of Malhotra.

In view of the above, Applicants submit that Claim 8 is novel over the film of Malhotra, and respectfully request removal of this ground for rejecting Claim 8.

#### **New Claims**

New Claim 9 depends from Claim 8 and further recites that the layer comprising polymers having pyrrolidinium rings in main chains thereof is not an adhesive layer. New Claim 9 is novel over the cited references for at least the reasons presented in regard to Claim 8 above. In addition, Claim 9 is further distinct from the teachings of AU 9640808A because AU 9640808A discloses that the layers containing pyrrolidinium rings are adhesive layers. Accordingly, Claim 9 is further novel over AU 9640808A.

New Claims 10 and 11 depend from Claim 8 and further recites that the thickness of said adhesive layer is about 3-100  $\mu\text{m}$ , and about 5-40  $\mu\text{m}$ , respectively. New Claims 10 and 11 are novel over the cited references for at least the reasons presented in regard to Claim 8 above. In addition, Claims 10 and 11 are further distinct from the teachings of Malhotra because Malhotra teaches that, “[w]hen an adhesive layer is employed, it preferably forms a uniform and continuous layer having a thickness of about 0.5 micron or less to ensure satisfactory discharge during the imaging process.” (Malhotra at column 12, lines 59-62). Accordingly, Claims 10 and 11 are further novel over Malhotra.

New Claim 12 depends from Claim 8 and further recites that the base material film comprises polyethylene terephthalates and/or polyethylene naphthalates. New Claim 12 is novel over the cited references for at least the reasons presented in regard to Claim 8 above. In

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addition, Claim 12 is further distinct from the teachings of the cited references because the cited references do not disclose a base material film comprising polyethylene terephthalates and/or polyethylene naphthalates. Accordingly, Claim 12 is further novel.

New Claim 13 is directed to a transparent conductive substrate comprising a substrate and the surface protective film of Claim 8 attached on a surface of the substrate. Thus, Claim 13 contains all elements of Claim 8. New Claim 13 is novel over the cited references for at least the reasons presented in regard to Claim 8 above. In addition, Claim 13 is further distinct from the teachings of the cited references because the cited references do not disclose a substrate and the recited surface protective film attached on a surface of the substrate. Accordingly, Claim 13 is further novel.

### CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

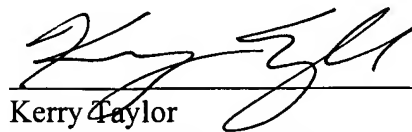
Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 29, 2006

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